

United States District Court
For the Northern District of California

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6 GEO. M. MARTIN COMPANY, a
7 California corporation, and THE
8 MARTIN FAMILY TRUST – 1989,

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10 No. C 07-00692 WHA

11 Plaintiffs,

12 v.
13 ALLIANCE MACHINE SYSTEMS
14 INTERNATIONAL, LLC, a Wyoming
15 corporation,

16 Defendant.
17 _____ /
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**OMNIBUS ORDER ON
MOTIONS IN LIMINE
(TENTATIVE RULINGS)**

19 This is a tentative ruling on all motions *in limine*. Counsel are free to argue for and
against the tentatives at the final pretrial conference, subject to time limits.

20 **PLAINTIFFS' MOTION IN LIMINE NO. 1 (SURVEY):**

21 **GRANTED** as to survey. Expert did not conduct survey. Instead, it was spoon-fed to
22 expert by counsel and client. Usage is fact-based, not for expert opinion. Important factual
23 points should not be proven through experts spoon-fed by wholly biased sources. If the
24 underlying fact witnesses were timely disclosed under Rule 26, then *they* may be called.
25 Defense counsel sandbagged plaintiffs' counsel as well by cloaking this "survey" in a claim of
26 privilege until after fact discovery had closed. Experts, however, can testify as to how the range
27 of usage (otherwise in evidence) would inform the damage analysis.
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1 **PLAINTIFFS' MOTION IN LIMINE NO. 2 (ANDERSON/VISY):**

2 **GRANTED.** The efficacy of the Visy machine must be proven up via fact witnesses, not
3 via the speculation of Anderson. The basis of his speculation is too remote and too flimsy to be
4 admissible under Rule 403.

5 **PLAINTIFFS' MOTION IN LIMINE NO. 3 (STAUFFER):**

DENIED WITHOUT PREJUDICE to question-by-question objections. The criticisms of Stauffer are best brought out on cross-examination.

8 **PLAINTIFFS' MOTION IN LIMINE NO. 4 (FORDE LAWSUIT):**

9 The *Forde* lawsuit will be excluded subject to possible allowance as to the issues of the
10 safety lockout system and the warranty expenses, both of which must be cleared first with the
11 judge before referencing before the jury.

12 || **PLAINTIFFS' MOTION IN LIMINE No. 5 (SCOTT);**

13 The Scott declaration may not be used for any purpose, including by any expert due to
14 Scott's refusal to appear for a deposition and to be cross-examined. Whether Scott would be
15 allowed to testify live would depend on factors not fully explained. If and when he shows up
16 live in court, we will hold a hearing out of the presence of the jury on whether to allow his
17 testimony.

PLAINTIFFS' MOTION IN LIMINE NO. 6 (TECASA):

19 **DENIED.** Plaintiffs are wrong in asserting that they have conclusively carried their
20 burden to establish by clear and convincing evidence an invention date earlier than their own
21 presumed date of invention, much less, the date of the Tecasa patent.

PLAINTIFFS' MOTION IN LIMINE No. 7 (VISX, '267 PATENT):

DENIED WITHOUT PREJUDICE to question-by-question objections.

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DEFENDANT'S MOTION IN LIMINE No. 1 (KARVELIS):
DENIED. The Liberty video testimony and doctrine of equivalents analysis presented in the Karvelis reply report are offered to rebut specific material in Stauffer's expert report which could not have been anticipated by Karvelis when his opening report was filed. Stauffer has

1 testified that he only came up with his non-infringement argument for the “bundle breaking
2 plane” limitation after Karvelis filed his opening expert report (Stauffer Dep. 127:20–128:4).
3 Significantly, Alliance did not even request “bundle breaking plane” or “gap” — the key terms
4 Alliance objects to in the reply report — to be construed at the claim construction hearing.
5 Only on Alliance’s motion for summary judgment of non-infringement were these terms even
6 an issue. Even then, Alliance’s proposed construction was rejected.

7 **DEFENDANT’S MOTION IN LIMINE No. 2 (SILVERMAN):**

8 **PROVISIONALLY GRANTED** as to reasonable royalty and allocation among plaintiffs.
9 The issue of whether George M. Martin Company is an exclusive licensee was obvious from
10 Day One. Plaintiffs should have prepared a reasonable royalty analysis as an alternative in
11 their main analysis. To sneak it in the “reply” report for the first time was sandbagging and
12 unjustified. Plaintiffs are wrong to try to blame defendants for raising an obvious issue and
13 then to assign it as good cause for late submission. The Court will, however, revisit the issue
14 when the time comes for plaintiffs’ rebuttal case to see if any of the equities have changed
15 such that Silverman may return and testify on rebuttal. Silverman may, however, correct the
16 double-counting error in his opening.

17 **DEFENDANT’S MOTION IN LIMINE No. 3
(CONCEPTION AND REDUCTION TO PRACTICE DOCUMENTS):**

18 **GRANTED** as follows:

19 Local Patent Rule 3.2(b) required plaintiff to produce “all documents evidencing the
20 conception, reduction to practice, design and development of each claimed invention, which
21 were created on or before the date of application for the patent in suit” Plaintiffs identified
22 ten pages in this category, numbered MART 157–66. This was never amended. These, then,
23 shall be the only *documents* advanced by plaintiffs to prove an earlier date of invention.
24

25 It may well be that plaintiffs produced other documents in discovery that arguably bear
26 on the issue but they were not designated as such. Those documents may or may not come in
27 for other purposes but they may not be advanced and offered for the purpose of proving an
28 earlier invention date. The rule has a very clear purpose — to make plain the specific
documents that will be used to corroborate an earlier invention date. This should not and

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1 can not be defeated at trial by advancing other isolated documents in the discovery universe to
2 beef up the earlier-invention timeline. Plaintiffs have not carried their burden to show the
3 Rule 3.2(b) violation was harmless or substantially justified.

4 This ruling does not, however, preclude *testimony*. That will have to be determined
5 question-by-question. Nor does this ruling preclude plaintiffs from trying to prove an earlier
6 date of invention. It does preclude plaintiffs from relying on any *documents* other than
7 MART 157–66 to prove an earlier date of invention.

8 **DEFENDANT'S MOTION IN LIMINE No. 4 (BB-III v. QUICKBREAK):**

9 **GRANTED.** One of the worst abuses in patent cases is to dazzle the jury with the
10 similarities between the competing machines, rather than comparing the accused machine
11 against the claims in suit. While the *Quickbreak* made by Martin may be referenced, it may not
12 be shown to the jury absent advance clearance by the Court.

13 **CONCLUSION**

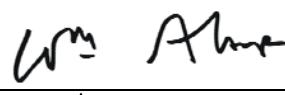
14 All counsel must be aware that a denial of a motion *in limine* does *not* mean that an
15 issue has been ruled *into* a trial. Rather, it means that it will not be ruled *out* of the trial on the
16 specific ground raised in the motion. Counsel must also be aware that when a motion *in limine*
17 is granted to exclude evidence, counsel winning the motion may open the door to its admission
18 via conduct that would make it unfair to continue to exclude it.

19 We will first try the issue of whether George M. Martin Company was an exclusive
20 licensee when this suit commenced. Once a verdict or finding is made on that issue, we will
21 finish the rest of the trial. At the final pretrial conference, counsel shall please be prepared to
22 address whether the exclusive-license issue is for the jury versus the Court and, even if for the
23 Court, whether it may be submitted to the jury anyway.

24 **IT IS SO ORDERED.**

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26 Dated: May 2, 2008.

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WILLIAM ALSUP
UNITED STATES DISTRICT JUDGE